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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,955	10/11/2001	John C. Murray	P 283374 HT-3046 CIP2	7402

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PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

REIS, TRAVIS M

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 09/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

Applicant(s)

09/973,955

MURRAY, JOHN C.

Examiner

Art Unit

Travis M Reis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. Claim 9/8/3/2/1 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7/6/5/3/2/1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, & 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufmann (DE 3621368 A1) in view of Choi (U.S. Patent 5544420) & Beeber (U.S. Patent 2994958).

With reference to claims 1, 19, & 21, Kaufmann discloses a retractable rule assembly comprising a housing assembly (20); a reel (18) rotatably mounted in said housing assembly; an elongated blade (4) formed of a ribbon of metal having one end connected to said reel, said blade extendable from a position tangential to said reel outwardly through a spaced opening in said housing assembly, a relatively short free end portion of said blade having a film of plastic material (9) overlying said protective

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coating on at least one of the convex and concave side of the blade, said film of plastic material having a thickness (Figures 1-7).

Kaufmann does not disclose expressly said elongated blade having a concavo-convex configuration when extended from said housing assembly, said elongated blade having measuring indicia formed on the concave side thereof; a coil spring formed of a ribbon of metal constructed to rotate said reel in said housing assembly in a direction to wind up the elongated blade when extending outwardly of said housing assembly opening in said concavo-convex cross-sectional configuration onto said reel in an abutting volute coil formation in a flattened cross-sectional configuration, and a blade holding assembly constructed to hold the blade in any position of extension outwardly of said housing assembly opening and to release the blade from any position in which it is held.

Choi discloses a combination tape measure and light bulb with a concavo-convex blade(Figure 5), a coil spring (30) to wind up the elongated blade, and a blade holding assembly (25) to hold the blade in an extended position. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to shape the blade disclosed by Kaufmann in the concavo-convex fashion as taught by Choi in order that the tape is self-straightening. In addition, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the spring and holding assembly disclosed by Choi to the retractable rule disclosed by Kaufmann in order that the metal blade is self-reeling, and is settable to fixed lengths.

Kaufmann does not disclose expressly a clear, plastic, protective coating less than .0035" thick and made of a material selected from the group consisting of: polyamides, polyvinyl, polyesters, silicone, polyimides, polyethylene, fluoropolymers and polyethylene terephthalate; provided on both said concave and convex side of said blade throughout the length of the blade for inhibiting wear of said measuring indicia.

Beeber discloses measuring tape (2) with a clear plastic coating (8) provided on both sides of the measuring tape ranging from .003" to .004" (col. 1 lines 55-60) and made of polyethylene glycol terephthalate (col. 2 lines 52-3) for durable protection of the blade (Figure 4). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the protective coating disclosed by Beeber to the blade disclosed by Kaufmann in order to durably protect the blade from electricity and water.

With reference to claim 2, Kaufmann does not disclose expressly wherein said film is comprised of a material selected from a group consisting of polyurethane, Mylar and Nylon. The particular type of material used to make the film, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a

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material on the basis of suitability for intended use of an apparatus would be entirely obvious.

With reference to claim 13, Kaufmann does not disclose expressly the film of plastic material has measuring indicia formed thereon.

Choi discloses indicia formed upon the coating (Figure 4). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the indicia disclosed by Choi to the film disclosed by Kaufmann in order that measurements can be seen clearly without obstruction.

With reference to claims 14-16, Kaufmann discloses the film of plastic material comprises a plurality of layers (4, 9, 11, 12, 15, 19) of plastic material & reinforcing members (15, 16) which can be made of fiber (Figures 5 & 6).

With reference to claims 17 & 18, Kaufmann discloses the film of plastic material extends across 100% of the blade width (Figures 3 & 7).

With reference to claim 20, Kaufmann discloses said indicia is provided by a layer of paint (11) between said blade and said protective coating (Figures 3 & 7), but does not disclose expressly said layer of paint having a thickness of between .0006" - .0014". However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a layer of paint having a thickness of between .0006" - .0014" in order that the blade remains bendable, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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4. Claims 3-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufmann, Choi, & Beeber as applied to claims 1, 2 & 13-21 above, and further in view of Bradshaw et al. (U.S. Patent 4900392).

With reference to claim 3, Kaufmann, Choi, & Beeber disclose all of the instant claimed invention as stated above in the rejection of claims but do not disclose expressly said film selected from said group is secured to said plastic coating with an acrylic adhesive.

Bradshaw et al. discloses a slidable indicia alignment and transfer device that uses an acrylic adhesive which is common to the art of securement (col. 4 lines 27-39). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the acrylic adhesive taught by Bradshaw et al. to the coating taught by Kaufmann, Choi, & Beeber in order that a commonly known adhesive keeps the coating secured to the blade.

With reference to claim 4, Kaufmann, Choi, & Beeber disclose said film extends from the free end of the blade to approximately the point where the blade is in said abutting volute configuration when said blade is fully retracted (Figures 1 & 2).

With reference to claim 5, Kaufmann, Choi, & Beeber all of the instant claimed invention as stated above in the rejection of claims 1, 2, & 13-21 but do not disclose expressly the length (X) of the portion of the blade covered by said film is approximately 12 inches or less (Figure 3). However, to choose a 12-in maximum distance over the blade, absent any criticality, is only considered to be the " optimum " value of the maximum distance over the blade, as stated above, that a person having ordinary skill

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in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

With reference to claim 6, Kaufmann, Choi, & Beeber all of the instant claimed invention as stated above in the rejection of claims 1, 2, & 13-21 but do not disclose expressly said film has a thickness dimension within a range of 0.006" to 0.014". However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the film having a thickness of between .0006" - .0014" in order that the blade remains bendable, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufmann, Choi, & Beeber as applied to claims 3-6 above, and further in view of Ballou (U.S. Patent 1303756).

With reference to claims 7-10, Kaufmann, Choi, & Beeber all of the instant claimed invention as stated above in the rejection of claims 3-6 including said retractable rule further comprises an end hook member (7) formed of sheet metal of a predetermined thickness (Figures 1-3), the plastic film go from about 2" to 12" inches; said film can have a thickness dimension within a range of 0.006" to 0.014"; said housing opening has a height dimension which exceeds the height dimension of said hook member mounting portion and its connection with the free end of said blade an

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amount which is at least approximately equal to the amount said hook portion extends below said bottom end surface of said housing assembly when at said housing opening (Figure 2); and the lateral edges of said mounting portion adjacent said hook portion provide upwardly facing surfaces (5) which engage one or more downwardly facing surfaces defining the housing opening to limit the upward movement of said hook member within said opening (Figure 1).

Kaufmann, Choi, & Beeber do not disclose expressly the hook member have a U-shaped hook portion that is bent at a generally right angle from an end of said mounting portion, and said end hook member being mounted on the free end of said blade with the mounting portion of said hook member being secured for limited movement with respect to the free end of the blade so that said rule can be measured externally from an exterior surface of said U-shaped hook portion or internally from an interior surface of said U-shaped hook portion; wherein the lateral edges of said blade extend outwardly and upwardly beyond the upwardly facing surfaces of said hook member mounting portion which engage said downwardly facing housing opening surfaces and deflect outwardly prior to the engagement of the upwardly facing surfaces of said mounting portion, said locking member including a blade engaging and locking free end portion, said locking free end portion including a central recess of a width to operatively accommodate the width of said hook member mounting portion..

Ballou discloses a U shaped hook portion that is bent at a generally right angle from an end of said mounting portion, and said end hook member being mounted on the free end of said blade with the mounting portion of said hook member being secured for

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limited movement with respect to the free end of the blade so that said rule can be measured externally from an exterior surface of said U-shaped hook portion or internally from an interior surface of said U-shaped hook portion, wherein the lateral edges of said blade extend outwardly and upwardly beyond the upwardly facing surfaces of said hook member mounting portion which engage said downwardly facing housing opening surfaces and deflect outwardly prior to the engagement of the upwardly facing surfaces of said mounting portion, said locking member including a blade engaging and locking free end portion, said locking free end portion including a central recess of a width to operatively accommodate the width of said hook member mounting portion (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the end hook member taught by Kaufmann, Choi, & Beeber with the U-shaped hook member disclosed by Ballou in order to hook onto measurement points more easily.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ruddy et al. discloses a variable stiffness U-shaped blade, rule employing the same, and a method of making same (U.S. Patent 4429462). Takahashi discloses a lifesaving apparatus with a reel and protective covering on the wire/tape (U.S. Patent 5581901). Nagasawa et al. disclose a self-straightening tape measure of synthetic resin and a process for preparing the same (U.S. Patent 4459753). Lee discloses a process for making a measuring tape with protective coating (U.S. Patent 5738743). Boege et al. discloses a strip-shaped resiliently flexible measuring tape for

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length or angle measuring devices (U.S. Patent 5979238). Fisher et al. discloses a layered measuring tape (GB 0100138A2). Nishikawa discloses a manufacture for tape measures (JP 357128801A). Nakai discloses a measuring tape and its manufacture (JP 404054401A). Konayashi et al. discloses a steel tape measure with protective coating (JP 404089501A).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (703) 305-4771. The examiner can normally be reached on 8:00--5:00 Monday--Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Travis M Reis
Examiner
Art Unit 2859



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

tmr
September 24, 2002